

Message Text

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FM SECSTATE WASHDC

TO AMEMBASSY TAIPEI

C O N F I D E N T I A L STATE 093168

E.O. 11652: GDS

TAGS: EIND, TW

SUBJECT: REPUBLIC OF CHINA GENERAL CENSUS ON TRADEMARKS

1. COMMERCE AND STATE HAVE BEEN INFORMED THAT THE NATIONAL BUREAU OF STANDARDS (NBS) OF THE ROC MINISTRY OF ECONOMIC AFFAIRS IS UNDERTAKING A GENERAL CENSUS OF TRADEMARK REGISTRANTS IN TAIWAN.

2. A QUESTIONNAIRE WILL BE SENT TO ALL REGISTRANTS, OR THEIR ATTORNEYS. FOREIGN REGISTRANTS MUST ANSWER ALL 41 QUESTIONS AND SEND THE REPLY WITHIN SIXTY DAYS TO THE NBS, ALONG WITH THE ORIGINAL CERTIFICATE OF TRADEMARK REGISTRATION. DOMESTIC REGISTRANTS MUST FILE WITHIN THIRTY DAYS. (WE ARE POUCHING COPIES OF THE NBS PUBLIC ANNOUNCEMENT AND QUESTIONNAIRE.)

3. THE PRESENT CENSUS IS LIMITED TO THOSE REGISTRATIONS PUBLISHED ON OR BEFORE JANUARY 1, 1974. ANY REGISTRANT, WHO HAS NOT RECEIVED A QUESTIONNAIRE BY MAY 15, IS RECONFIDENTIAL

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QUESTED TO CONTACT THE NBS. IF THE QUESTIONNAIRE IS NOT RETURNED WITHIN THE PRESCRIBED TIME (APPARENTLY JUNE 30, 1975), THE REGISTRATIONS INVOLVED MAY BE REVOKED. ACCORDING TO THE NBS PUBLIC ANNOUNCEMENT, THE LEGAL BASIS FOR

THE CENSUS IS ARTICLE 31 AND ARTICLE 52 OF THE TRADEMARK

LAW AND THE LETTER OF THE EXECUTIVE YUAN (CABINET), REF NO. CHUNG-SHO-FIRST 2703. ARTICLE 31 SETS FORTH THE GROUNDS UPON WHICH A TRADEMARK REGISTRATION MAY BE REVOKED BY ADMINISTRATIVE AUTHORITIES. ARTICLE 52 DEFINES CONDITIONS UNDER WHICH A REVIEW FOR POSSIBLE TRADEMARK INVALIDATION MAY BE SOUGHT. WE DO NOT HAVE A COPY OF THE ABOVE-MENTIONED EXECUTIVE YUAN LETTER AND WOULD APPRECIATE EMBASSY'S FORWARDING THIS ASAP.

4. A NUMBER OF AMERICAN FIRMS WITH TRADEMARK REGISTRATIONS IN ROC HAVE EXPRESSED CONCERN OVER THIS QUESTIONNAIRE. THE U.S. CHAMBER OF COMMERCE HAS ALSO RECEIVED A LETTER FROM THE CONFEDERATION OF BRITISH INDUSTRY (COPY BEING POUCHED) EXPRESSING SIMILAR CONCERN ON BEHALF OF ITS MEMBER FIRMS. COMPANIES POINT OUT THAT MUCH OF THE INFORMATION REQUESTED IS ALREADY IN POSSESSION OF THE GROC TRADEMARK AUTHORITIES AND ARGUE THAT COMPLETING THE QUESTIONNAIRE WILL INVOLVE CONSIDERABLE EXPENSE. MANY FIRMS SPECIFICALLY OBJECT TO THE REQUIREMENT TO DISCLOSE THEIR OTHER FOREIGN REGISTRATIONS, WHICH INFORMATION THEY ARGUE HAS NO RELEVANCE TO THEIR TRADEMARKS IN THE ROC. THEY BELIEVE THAT INFORMATION REVEALED TO THE GROC ABOUT HOW THEY DEAL WITH TRADEMARK INFRINGEMENT COULD PREJUDICE ANY FUTURE OPPOSITION OR INFRINGEMENT PROCEEDINGS THEY MIGHT INITIATE IN TAIWAN. FURTHERMORE, FIRMS ARGUE THAT THE SHEER AMOUNT OF INFORMATION SOUGHT COULD LEAD TO CHARGES THAT THE RESPONDENT'S REPLY IS INCOMPLETE OR INCORRECT, THEREBY SUBJECTING HIM TO TRADEMARK CANCELLATION. IN ADDITION, BUSINESSMEN ARE DISTURBED BY THE GROC REQUEST THAT THE ORIGINAL CERTIFICATE OF A TRADEMARK REGISTRATION ACCOMPANY THE REPLY TO THE QUESTIONNAIRE. FINALLY, U.S. GOVERNMENT AND TRADEMARK AUTHORITIES CONSIDER THIS TYPE OF GOVERNMENT SURVEY AN UNPRECEDENTED PROCEDURE FOR ADMINISTERING A TRADEMARK SYSTEM.

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5. THE EMBASSY IS REQUESTED TO DISCUSS THIS MATTER ON AN URGENT BASIS WITH APPROPRIATE GROC OFFICIALS AND TO INFORM THEM OF U.S. GOVERNMENT'S CONCERN ABOUT THE TRADEMARK CENSUS AND QUESTIONNAIRE. THIS CONCERN IS BASED ON COMPLAINTS RECEIVED FROM U.S. FIRMS ON THE POSSIBLE IMPAIRMENT THAT COULD RESULT TO THEIR TRADEMARK RIGHTS. IN YOUR APPROACH, YOU SHOULD DRAW ON THE FOLLOWING POINTS.

6. AUTHORITY FOR THE CENSUS. THE EMBASSY SHOULD POINT OUT THAT, IN THE U.S. VIEW, AUTHORITY FOR THE CENSUS, UNDER ARTICLES 31 AND 52 OF THE TRADEMARK LAW, IS QUESTIONABLE. THE PHRASES "IN ANY OF THE FOLLOWING EVENTS..." IN ARTICLE 31, AND "IF THE REGISTRATION OF A TRADEMARK IS

IN VIOLATION OF..." IN ARTICLE 52, CLEARLY IMPLY THAT

PARTICULAR TRADEMARK REGISTRATIONS WOULD BE SUBJECT TO REVIEW FOR VALIDITY ONLY ON A CASE-BY-CASE BASIS. THE EXISTING TRADEMARK LAW ALREADY ENCOMPASSES PROCEDURES WHICH ENABLE INTERESTED PARTIES AND GOVERNMENT AUTHORITIES TO CHALLENGE THE VALIDITY OF A TRADEMARK REGISTRATION OR DETERMINE WHETHER REGISTRANT HAS MET PERIODIC REQUIREMENTS OF THE LAW. THE STANDARD PROCEDURE IN TRADEMARK PRACTICE IS TO HANDLE CHALLENGES TO VALIDITY ON A CASE-BY-CASE BASIS. A GENERAL CENSUS, AS ENVISAGED BY THIS QUESTIONNAIRE, IS A COMPLETELY UNPRECEDENTED WAY OF DETERMINING THE VALIDITY OF TRADEMARKS UNDER NATIONAL LAW.

7. THE QUESTIONNAIRE. THE EMBASSY SHOULD POINT OUT THAT IN MANY CASES BOTH THE QUESTIONS AND PURPOSES BEHIND THEM ARE UNCLEAR AND EXPOSE THE RESPONDENT TO A NUMBER OF RISKS RELATIVE TO HIS TRADEMARK RIGHTS. THIS IS PARTICULARLY TRUE WITH RESPECT TO THE FOLLOWING QUESTIONS OF THE QUESTIONNAIRE:

PART III. QUESTIONS 10 - 11. THE MEANING OF "REPRESENTATIVE" IS NOT CLEAR. ALSO, A COMPANY MIGHT HAVE MANY DOMICILES, DEPENDING UPON HOW ONE CONSTRUES THE WORD "DOMICILED." A WRONG CONSTRUCTION COULD HAVE SERIOUS REPERCUSSIONS AS TO APPLICABILITY OF TAX AND OTHER LAWS, ALL OF WHICH ARE UNRELATED TO THE PURPOSES OF THE TRADEMARK STATUTE. NEVERTHELESS, A FALSE OR INCOMPLETE ANSWER

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COULD LEAD TO REVOCATION OF THE TRADEMARK REGISTRATION.

PART IV. QUESTIONS 12 AND 13. THE PURPOSE OF THESE QUESTION IS NOT CLEAR.

PART V. QUESTION 16. THERE IS NO PROVISION IN THE QUESTIONNAIRE FOR A REGISTRANT WHO REPORTS NON-USE OF HIS TRADEMARK REGISTRATION TO INDICATE THAT HE HAS "GOOD CAUSE" FOR BEING UNABLE TO USE IT, IF SUCH BE THE CASE (SEE TRADEMARK LAW ARTICLE 31(2)). ALSO A REGISTRANT HAS NO OPPORTUNITY TO PROVIDE A DEFENSE FOR NON-USE, IF THE GROC DECIDES TO CANCEL HIS MARK.

QUESTION 19. INFORMATION ON FOREIGN REGISTRATIONS HAVE NO RELEVANCE TO THE VALIDITY OF A MARK IN THE GROC, AND IS COMMERCIALY SENSITIVE FOR COMPETITIVE AND OTHER REASONS.

PARTS VI THROUGH VIII. QUESTIONS 21 - 35. DISCLOSURE OF EXPERIENCE AS TO INFRINGEMENTS COULD BECOME AVAILABLE TO POTENTIAL INFRINGERS TO THE DETRIMENT OF THE TRADEMARK OWNER.

PART X. QUESTION 37. THE REQUEST FOR THE ORIGINAL OF THE

REGISTRATION CERTIFICATE IS TOTALLY UNNECESSARY. FIRMS SHOULD NOT BE FORCED TO RISK POSSIBLE LOSS OF THIS COMMERCIAL DOCUMENT. ALSO, INACCURATE OR INCOMPLETE REPLIES COULD JEOPARDIZE REGISTRATIONS, E.G., IF OWNER INDICATES HIS MARK HAS NEVER BEEN INFRINGED AND LATER FINDS THAT AT TIME OF STATEMENT, IT WAS BEING INFRINGED IN TAIWAN.

8. RISKS TO THE INTERESTS OF OWNERS FROM FAILURE TO RESPOND. THE EMBASSY SHOULD ADVISE THE GROC AUTHORITIES THAT ALTHOUGH THE PUBLIC ANNOUNCEMENT HAS BEEN WIDELY CIRCULATED, IT IS LIKELY THAT MANY REGISTRANTS WILL NOT RECEIVE IT. THROUGH NO FAULT OF THE REGISTRANTS, THIS COULD CAUSE CANCELLATION OF A TRADEMARK AND CONSEQUENTLY EXPOSE IT TO PIRACY.

9. EMBASSY SHOULD ADDITIONALLY POINT OUT THAT (A) EXTENSIVE INFORMATION IS REQUIRED, MUCH OF IT ALREADY IN GROC CONFIDENTIAL

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RECORDS (B) COMPLETION OF THE QUESTIONNAIRE WILL REQUIRE BURDENSOME EXPENSE IN TIME AND FEES; (C) FIRMS ARE PARTICULARLY CONCERNED BY THE REQUEST TO SUPPLY THE ORIGINAL CERTIFICATE OF TRADEMARK REGISTRATION, AND BY THE POWER OF THE REGISTRAR TO INVALIDATE A MARK PREVIOUSLY REGISTERED, FOR REFUSAL TO FULLY ANSWER THE QUESTIONNAIRE OR RETURN IT WITHIN THE PRESCRIBED TIME.

10. EMBASSY IS REQUESTED TO SEEK (A) CLARIFICATION OF QUESTIONS 10 - 13 AS DISCUSSED IN PARAGRAPH (7) ABOVE, (B) PROVISION FOR STATEMENT OF REASONS AND DEFENSE FOR NON-USE OF A TRADEMARK UNDER QUESTION 16; (C) DELETION OF QUESTION 19; (D) AGREEMENT THAT PROVISION OF INFORMATION REQUESTED IN QUESTIONS 21 THROUGH 35 BE VOLUNTARY; (D) REMOVAL OF THE REQUIREMENT FOR THE SUBMISSION OF THE ORIGINAL CERTIFICATE OF REGISTRATION UNDER QUESTION 37; (E) EXTENSION OF THE TIME PERIOD PRESCRIBED FOR RETURN OF THE QUESTIONNAIRE TO OCTOBER 15, 1975, THE ENDING DATE OF THE STATED TERM OF THE CENSUS.

11. PLEASE REPORT FULLY THE GROC RESPONSE TO YOUR APPROACH. WE WOULD APPRECIATE KNOWING WHETHER YOU HAVE RECEIVED COMPLAINTS FROM LOCAL US FIRMS ON THE TRADEMARK CENSUS OR WHETHER ANY OTHER GOVERNMENTS OR INDUSTRY REPRESENTATIVES HAVE APPROACHED THE GROC ON THIS MATTER. KISSINGER

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<< END OF DOCUMENT >>

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